REMARKS

In the Action dated October 24, 2003, the Examiner has rejected claims 12-13 and 15 under 35 U.S.C. § 103(a) as being anticipated by *Stringer*, European Patent No. 0601500, in view of *Carroll*, United States Patent No. 6,530,019. That rejection is expressly traversed.

Claim 12, an exemplar of the claims of this group, expressly recites the provision of a personal computer system which is loaded with usable software comprising a processor, a storage device and "several programs loaded on the storage device in such a way as to make the programs unusable". Thereafter, a module associated with the processor is recited as making "selected" programs "active and usable . . ."

In clear contrast, *Stringer* teaches the so-called "try and buy" technique whereby actual operational software is loaded into a computer or transferred to the user of the computer and wherein that software is operational in either full function or limited function so that the user may evaluate the software and thereafter purchase the software, obtaining unrestricted full functional use of that material.

Thus, for example, at column 5, lines 17 *et seq. Stringer* teaches "the present invention allows a user to evaluate fully functional versions of original materials before purchasing the materials. Because the invention operates with any original material, there is no need for the author of the material to modify the original version to create a trial or evaluation version of the material. Rather, the invention allows any individual to transform an original version of the material into an evaluation without any special knowledge of the content of the original material."

Similarly, at column 13, lines 50-55, *Stringer* teaches "this embodiment of the present invention provides enhanced value and allows personal configuration by a pre-loading software,

ready to try, on a computer system. If the customer is satisfied with the software, the customer can purchase the product, and convert it to unlimited ownership."

The Examiner has now cited *Carroll* for an alleged teaching of a processor, storage device and programs loaded on the storage device in such a way as to make the programs unusable, citing column 3, lines 60 through column 4, line 15 and column 2, lines 20-25. Applicant respectfully urges the Examiner to consider that the present application is directed to a technique for providing appropriate software on personal computers for various employees throughout a large corporation where all of those employees may use selected software applications; however, selected employees will utilize software applications which are not utilized by other employees.

For example, at page 3 of the specification, lines 21, et seq., the system is described wherein an engineering organization, a manufacturing organization, graphics, administrative personnel, legal and customer service organizations are all present within a corporation and each of those organizations may utilize specific software applications which are not common to other organizations.

Thus, the claims in the present application are specifically and expressly directed as set forth within claim 12, as including a module for selecting "certain of the programs loaded on the personal computer and making those selected programs active and usable." A module is also recited within this claim as making the programs which were not selected permanently unusable.

Carroll, as cited by the Examiner, teaches a system in which all software, other than the boot sector on a hard drive storage device, is unusable as the computer is shipped by shipping the computer with a modified boot record which has incorrect data stored in the partition specification entries. (*See* column 4, lines 1-6.) Thus, the teaching of *Carroll* is that all software

applications stored within the hard disk drive are unusable, as those partitions other than the partition which contained the boot record cannot be reached due to the incorrect entries within that portion of the modified boot record.

Thereafter, once a user has agreed to accept the terms of a software contract, the boot record is modified so that software applications stored in other partitions can be accessed. Thus, as illustrated within *Carroll*, the software loaded into the hard disk drive is indeed initially unusable; however, once the modified boot record has been corrected, all software within the hard disk drive is thereafter usable. Thus, *Carroll* fails to teach a method or system whereby selected programs may be made active and usable while non-selected programs are placed in a permanently usable condition. Further, as *Stringer* expressly teaches that all forms of software loaded within the system are active and usable for evaluation purposes, Applicant urges that the combination of *Carroll* and *Stringer* is improper, as software could not be evaluated as taught by *Stringer* if it is initially loaded into a hard drive which is not accessible as taught by *Carroll*. Consequently, the attempted combination of *Carroll* and *Stringer* does clear violence to the teaching of each reference and, for this reason and the reasons set forth above, Applicant urges that the Examiner's rejection of claims 12-13 and 15 over this combination of references is improper.

Next, the Examiner has rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Stringer*, in view of *Carroll* as noted above, and further in view of *Wiedemer*, United States Patent No. 5,155,680. That rejection is not well founded and should be withdrawn.

The Examiner has cited *Wiedemer* for its teaching of a billing method which may include payment after selection, conversion and storage in a usable form; however, as no combination of *Wiedemer* with *Stringer* and *Carroll* shows or suggests in any way the loading of software in a

computer in an unusable form and the subsequent conversion of selected portions of that software into usable form, this rejection is also not to be believed as well founded and it should be withdrawn.

The Examiner has also rejected claims 1-2, 4-6 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Stringer* and *Carroll* as applied above and further in view of *Casey et al.*, United States Patent No. 6,243,745. That rejection is not well founded and it should be withdrawn.

The Examiner has cited *Casey et al.* for its alleged teaching of the selection of programs based upon a user's position or function; however, the addition of the *Casey et al.* citation to the combination of *Stringer* and *Carroll* fails to overcome the deficiency of *Stringer* and *Carroll* in that those references fail to show or suggest the loading of software into a computer in unusable form and these subsequent conversion of selected portions of that software into usable form as expressly set forth within the claims of the present application. Consequently, Applicant urges that this rejection should be withdrawn.

The Examiner has also rejected claim 3 under 35 U.S.C. § 103 as being unpatentable over *Stringer* and *Carroll*, in view of *Casey et al.*, as applied to claim 1 and further in view of *Wiedemer*. That rejection is respectfully traversed.

For the reasons set forth above, it is respectfully urged that no combination of these references can be said to show or suggest the invention expressly set forth within the claims of the present application, in that none of these references anticipates, shows or suggests, whether considered alone or in combination, the loading of software into a computer in an unusable form and the subsequent conversion of selected portions of that software into usable form as set forth

within the claims of the present application. Consequently, Applicant urges the Examiner to withdraw the rejection of claim 3.

Finally, the Examiner has rejected claims 9-11 and 16-21 under 35 U.S.C. § 103(a) as being unpatentable over *Stringer* and *Carroll*, in view of *Wiedemer* as applied to claims 7 and 8 above and further in view of *Casey et al.* That rejection is also respectfully traversed.

As set forth above, this combination of claims expressly recites the provision of software which is loaded into a computer in unusable form and the subsequent conversion of selected portions of that software into usable form. For the reasons set forth above, which fails to show or suggest such a technique, whether considered alone or in combination and it is respectfully urged that this rejection is improper and withdrawal of the rejection is respectfully requested.

In summary, Applicant urges that *Stringer*, which teaches the loading of fully operational software into a computer for evaluation purposes cannot be combined with *Carroll*, which teaches that operational software is loaded into a computer and placed in a hard disk drive in a manner such that the software cannot be accessed until after a user has agreed to comply with the terms of a software license agreement. No combination of these two references can be accomplished which does not do clear violence to the original reference in the combination and consequently, Applicant urges that such a combination is not proper.

Additionally, for the reasons set forth above, the enablement or non-enablement of access to software loaded within a hard disk drive fails to show or suggest, in the opinion of the Applicant, the ability to select particular portions of the software applications loaded within the computer and convert only those portions into usable form while the remaining software remains in unusable form, as set forth within the claims of the present application.

Consequently, Applicant urges that claims 1-21 define patentable subject matter and withdrawal of all rejections and passage of this application to issue is respectfully requested.

No extension of time is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time to IBM Corporation Deposit Account No. 50-0563.

Respectfully submitted,

Andrew J. Dillon
Reg. No.29,634
BRACEWELL & PATTERSON, L.L.P.
P.O. Box 969
Austin, Texas 78767-0969
(512) 542-2100
ATTORNEY FOR APPLICANTS